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In re Application of :
OUDERKIRK et al. :
Application No.:09/890,482 :
PCT No.: PCT/US99/018187 :
Int. Filing Date: 28 January 1999 :
Priority Date: 28 January 1998 :
Attorney Docket No.: 53852US013 :
For: INFRARED INTERFERENCE FILTER

DECISION ON PETITION

This is a decision on applicants' unsigned communication filed 13 January 2003 and "Communication Re: Courtesy Copy of Declaration" filed 14 February 2003.

BACKGROUND

On 28 January 1999, applicants filed international application no. PCT/US99/018187 which claimed a priority date of 28 January 1998. The international application named Andrew J. Onderkirk; Takashi Harada; Makoto Ishikawa; Akira Yoda; Tatsuya Nakamura; and H. Sanders Gwin as applicant/inventors. A Demand was filed for International Preliminary Examination prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 28 July 2000.

On 26 July 2001, applicants filed a Transmittal Letter for entry into the national stage accompanied, *inter alia*, by: the requisite basic national fee; a copy of the international application; a preliminary amendment; and a petition to revive under 37 CFR 1.137(b). The petition to revive was granted in a decision dated 05 November 2001.

On 08 November 2001, the United States Designated Office (DO/EO/US) mailed a Notification Missing Requirements under 35 CFR 371 (Form PCT/DO/EO/905) indicating that a signed oath/declaration of the inventors in compliance with 37 CFR 1.497(a) and (b) together with a surcharge payment were required. The notification set a two-month time limit in which to respond.

On 10 June 2002, the above-identified application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 08 November 2001 within the time period set therein.

On 14 February 2003, applicants filed present petition which was accompanied by: Completion of Filing Requirement with a declaration and power of attorney dated 08 January 2002; a postcard receipt dated 25 February 2002; and Request and Fee to Amend Inventorship under 37 CFR 1.48(c).

DISCUSSION

Petition under 37 CFR 1.181

A review of the application file reveals that the declaration and power of attorney submitted on 25 February 2002 is not located therein. The best evidence of what was actually received by the Office is a postcard receipt containing a specific itemization of all the items being submitted. See MPEP 503. The evidence submitted by applicant and the postcard receipt identifies the application by applicant, application serial number, and docket number. The receipt itemizes, *inter alia*: Completion of Filing Requirement in Duplicate with copy of Notification of Missing Requirements; and 4-page Declaration with Enclosures. The receipt is stamped "OIPE 25 FEB 2002" across its face is sufficient to indicate that the papers were in fact received in the Office on 25 February 2002.

Petition under 37 CFR 1.42

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by "all of the heirs" of the deceased inventor, where no legal representative has been appointed.

The declaration submitted on 25 February 2002 was executed by Yoko Ishikawa as "heir" to the deceased inventor Miakoto Ishikawa. However, the declaration does not state that Yoko Ishikawa is the sole heirs of the deceased inventor. Absent a statement that the signing heir is the sole heir of the deceased inventor, the declaration cannot be accepted under 37 CFR 1.42.

In addition, it is noted that revised 37 CFR 1.497(b)(2) states the following:

- (2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(a)(3) and 37 CFR 1.63, the declaration must also provide residence and post office address for the signing heir. The declaration filed on 08 February 2002 provides this information with respect to the signing heir, but not the inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(a)(3) and 37 CFR 1.63.

Request under 37 CFR 1.48(c)

Applicants request to add Michael F. Weber, John Wheatley, and Roger J. Strharsky as applicant/inventors. Michael F. Weber, John Wheatley, and Roger J. Strharsky state in the present petition that, "I (am) one of the inventors being added to the above-identified application, do hereby declare that my addition is necessitated by amendment of the claims . . ." 37 CFR 1.48(c) is directed at correcting the inventorship where the executed oath or declaration had correctly set forth the inventorship but due to amendment of the claims to include previously unclaimed but disclosed subject matter, one or more inventors of the amended subject matter must be added to the current inventorship. Correction of inventorship under 37 CFR 1.48(c) is only available in nonprovisional applications. As defined in 37 CFR 1.9(a)(3), a U.S. national stage application must first comply with the requirements of 35 U.S.C. 371(c) to constitute a "nonprovisional" application. In the present case, applicants have failed to comply with 35 U.S.C. 371 (c)(4), in that an oath or declaration, in compliance with 35 CFR 1.497(a)-(b), executed by the six inventors identified in the international application, has not been submitted.

CONCLUSION

Applicants' petition under 37 CFR 1.181 is **GRANTED**.

The request for status under 37 CFR 1.42 is **REFUSED**.

The petition under 37 CFR 1.48(c) is **DISMISSED** without prejudice.

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by the five inventors and the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

Any further correspondence with respect to this matter should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and be addressed to the Assistant

Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

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